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PTO/SB/21 (09-04) MODIFIED

1602

TRANSMITTAL FORM

Application Number: 09/030,599 09930559

Filing Date: 08/15/2001

First Named Inventor: Dawson

Art Unit: 1642

Examiner Name: Aeder, Sean

Attorney Docket Number: ARCD:351US

ENCLOSURES (check all that apply)

☐ Fee Transmittal Form
☐ Fee Attached

☒ Amendment/Reply
☐ After Final
☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement
☐ Form PTO-1449
☐ References

☐ Certified Copy of Priority Documents

☐ Reply to Missing Parts/Incomplete Application
☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
☐ Declaration(s)
☐ Copy of Notice of Missing Parts

☐ Drawings(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a Provisional Application

☐ Power of Attorney, Revocation, Change of Correspondence Address
☐ Statement under 37 CFR §3.73(b)
☐ Designation of Patent Practitioners

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number CD(s)
☐ Landscape Table on CD

☐ After Allowance Communication to TC

☐ Appeal Communication to Board of Appeals and Interferences

☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

x=X Other Enclosure(s) (please identify below)

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☐ Sequence Statement

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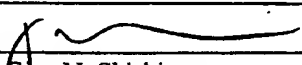
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Date: June 17, 2005

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Typed or Printed Name: Gina N. Shishima Date: June 17, 2005

Transmittal Form to Commissioner for Patents

June 17, 2005

Our reference: ARCD:351US

Your reference: UCHI:812



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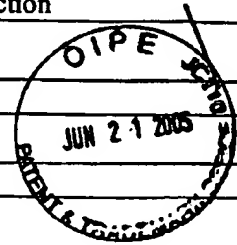
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<input type="checkbox"/> New Application For:	Priority Date: 08/15/2001
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IDENTIFICATION OF APPLICATION

Serial No.: 09/930,599 09930559	
Title: COMPOUNDS THAT ENHANCE TUMOR DEATH	
Applicant: Dawson, et al.	Attorney: GNS
Client: Arch Development Corp.	F&J File No.: ARCD:351US
Mailed: June 17, 2005	Filed: Due Date:





PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Glyn Dawson
Seongeun Julia Cho

Serial No.: 09/930,559

Filed: August 15, 2001

For: COMPOUNDS THAT ENHANCE
TUMOR DEATH

Group Art Unit: 1642

Examiner: Aeder, Sean

Atty. Dkt. No.: ARCD:351US

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June 17, 2005 Date	 Gina N. Shishima

Commissioner for Patents
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Commissioner:

This paper is submitted in response to the Restriction Requirement dated May 17, 2005 for which the date for response is August 17, 2005.

It is believed that no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/ARCD:351US.

In response to the restriction requirement which the Examiner imposed, Applicants elect, with traverse, to prosecute claims 1-6, 8-10, 15-23, 27, 32-37, and 42-46, *i.e.*, the Group 3 claims for the reasons discussed below.

Applicants traverse the restriction requirement because Group I necessarily includes Group III. Group I is distinguished from Groups II and III because it recites a peptide that comprises at least or at most 5 contiguous amino acids from SEQ ID NO:3. SEQ ID NO:3 sets forth the amino acid sequence GCVKIKK. Group III is distinguished from Groups I and II for reciting a peptide that is DAP1. DAP1 is a peptide that that is AcG-palmitoyl diamino priopionate-VKIKK. *See e.g.*, specification at page 7, lines 11-12.

The Restriction indicates that "Groups I-III represent chemically distinct methods comprised of a multitude of different amino acid sequences." Restriction at page 4. However, it is clear that DAP1 has the VKIKK sequence from SEQ ID NO:3. Moreover, the structure and content of the originally filed claims makes this clear. Claim 11 recites "wherein the peptide comprises at least or at most 5 contiguous amino acids from SEQ ID NO:3." Claim 12 depends from claim 11 and recites "wherein the peptide comprises the sequence VKIKK." Both claims 11 and 12 were identified as belonging to Group I. Claim 22 recites "wherein the peptide is DAP1." Significantly, claim 22 depends from claim 12, but claim 22 was designated in Group III and not in Group I (as claim 12 was).

Applicants contend that a search for both Groups I and III would not be undue because this would involve searching for any five contiguous amino acid sequence from SEQ ID NO:3, which is only 8 amino acids long.

Furthermore, Applicants note that there are linking claims encompassing both Group I and III (claims 1-6 and 8-10) and claim 11 itself is a linking claim for Group III. The MPEP indicates that one of the most common linking claims is a "genus claim linking species claims." MPEP § 809.03. Applicants remind the examiner that the linked claims "must be examined with

any one of the linked inventions that may be elected." M.P.E.P. § 814. The MPEP specifically indicates:

Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions. MPEP §809.04.

Therefore, if the claimed method is deemed allowable with respect to DAP1, a search will necessarily have to be done with respect to the linking claims, which includes a search of SEQ ID NO:3, a set forth in linking claim 11.

Consequently, for the foregoing reasons Applicants respectfully request that Groups I and III be rejoined.

The Examiner is invited to contact the undersigned attorney at (512) 536-3081 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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Date: June 17, 2005